REMARKS

Status of Claims

Claims 1, 3-9, and 11-16 were pending in this application. Claim 14 has been amended and claims 15-16 have been cancelled. Claims 1, 3-9, and 11-14 are pending in this application. Reconsideration of the rejections of all claims and allowance are earnestly solicited in view of the amendments and the following remarks.

Substance of the Interview

Applicants thank Examiner Huynh for conducting the interview on February 27, 2006 and for considering the arguments regarding the deficiencies of the prior art, including Rodden and Buote. During the interview Examiner Huynh clarified the grounds for the 35 U.S.C. § 112, second paragraph rejection. The Examiner stated that the omitted steps include what occurs when the window is new, which could be illustrated with language such as "if the window is new." Applicants do not agree that this language is necessary to the claimed invention. Additionally, we discussed the strength of the 35 U.S.C. § 103(a) rejection, focusing on claims 1 and 4. Among other things, arguments were presented that Rodden and Buote fail to determine whether the size and position are specified for a window and if the size and position are specified rendering the window at the specified size and position. Additionally, arguments were presented that Rodden and Buote fail to disclose a restore button to reduce the size of the window a predetermined amount, when the restore button has been initiated.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 14-16 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps.

Applicants disagree with the Office Action's contention that checking the window to determine whether the window is a new window omits essential steps. During the interview the Examiner indicated that it is necessary to define actions that occur after checking the window by particular stating "if the window is new." Applicants respectfully disagree because the actions are present in the current claim language. Applicants have amended claim 14 and cancelled claims 15-16 to overcome the 112, second paragraph rejection by removing the language from the claims. Accordingly, the 35 U.S.C. § 112, second paragraph rejection should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 3-9, and 11-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,473,102 to Rodden *et al.* (hereinafter "Rodden"), in view of U.S. Patent No. 6,581,020 to Buote *et al.*, (hereinafter "Buote"). This rejection is respectfully traversed.

With respect to claims 1 and 8, Rodden and Buote fail to suggest or disclose "if the size and position are not specified, determining the screen resolution for the display screen and automatically maximizing the size of the window on the display screen if the screen resolution is below a pre-determined threshold value, wherein the screen resolution does not change."

The combination of Rodden and Buote would render both Buote and Rodden inoperable for their intended purposes. Buote expressly discloses that window mode

windows may be moved around on the desktop, but may not be resized. U.S. Patent No. 6,473,102 (issued Oct. 29, 2002) col. 11, ll. 20-21. While Rodden discloses a method and system that automatically repositions and resizes windows in response to movement of the window or changes in a display configuration. U.S. Patent No. 6,473,102 (issued Oct. 29, 2002) col. 1, ll. 50-55. If the alleged combination of Rodden and Buote were performed, Rodden would no longer be able to perform actions associated with resizing because the window size would be locked. Alternatively, when an event, such as changing the resolution to 600X800 occurs, Buote would maximize all windows without calculating the size and position of the window as required by Rodden. Thus, the combination of Buote and Rodden is improper because the Office has not provided a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly the rejection of claims 1 and 8 should be withdrawn.

Even if Buote and Rodden could be combined without destroying the functionality of one of the references, Buote and Rodden fail to disclose or suggest the requirement of "if the size and position are not specified, determining the screen resolution for the display screen and automatically maximizing the size of the window on the display screen if the screen resolution is below a pre-determined threshold value, wherein the screen resolution does not change."

The Office Action concedes that Rodden does not disclose comparing the screen resolution against a predetermine threshold and automatically maximizing the size of the window on the display screen if the screen resolution is below a predetermined threshold, wherein the screen resolution does not change. However, the Office Action cites Rodden

for disclosing, "if the size and position are not specified, determining the screen resolution for the display screen."

The Office Action cites Rodden column 1, lines 22-28 and column 3, lines 62-66 to disclose this requirement. The portions cited by the Office Action do not mention determining a screen resolution if the size and position are not specified. Contrary to the Office Actions contention nowhere in Rodden is there a disclosure or suggestion of determining the screen resolution when the size and position are not specified. Column 1, lines 22-28 discloses providing the user with the ability to alter a resolution associated with a display, and discusses the effects of such a change on the displayed content. Similarly, column 3, lines 62-66 discloses the ability of a user to change the resolution of a screen and the effects on the text and objects appearing in the window. This is far different from the claimed requirement of determining a screen resolution if the size and position are not specified. Nothing in Rodden teaches or suggests determining the screen resolution when the size and position are not specified. This requirement is fundamental to determining whether to maximize.

Rodden is deficient with regard to determining the screen resolution when the size and position are not specified and Buote fails to supply this missing requirement. Instead Buote discloses an **all** or nothing system where all windows are maximized for a specified resolution. U.S. Patent No. 6,473,102 (issued Oct. 29, 2002) col. 11, ll. 15-19. Alternatively, at another resolution **all** the windows are created in a window mode, which prevents resizing. *Id.* at col. 11, ll. 18-21. Thus, Rodden and Buote, singularly or in combination fail to teach or suggest the missing requirement.

The Office Action argues that Buote discloses comparing the screen resolution to a predetermined threshold value and automatically maximizing the size of the window on the display screen if the screen resolution is below the predetermined threshold value. Applicants disagree, Buote does not suggest or disclose, "comparing the screen resolution against a threshold." Buote fails to mention the word "threshold" anywhere in the disclosure, much less maximizing the window based on a comparison of the screen resolution to a threshold. The Office Action relies on an alleged inherent teaching of Buote related to the resolution conditions disclosed by Buote. *Id.* at col. 11, ll. 15-22. Despite the disclosure of these conditions, Buote still fails to expressly or inherently disclose the ability to intelligently maximize a window based on a comparison. Instead Buote simply discloses conditions associated with maximizing a window. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.) The Office action suggests that comparing a threshold is inherent, but fails to provide support that clearly illustrates the inherency of comparing a screen resolution to a threshold.

Finally, neither Rodden nor Buote discloses performing the claimed requirements when the screen resolutions do not change. Rodden expressly indicates that the resizing and repositioning occurs in response to a change in screen resolution. U.S. Patent No. 6,473,102 (issued Oct. 29, 2002) col. 4, ll. 20-30 and 40-50. While Buote, if combined with Rodden to supply a disclosure that the screen resolution does not change, would effectively destroy the primary operation of Rodden, the primary operation being to detect changes in screen resolution to reposition or resize an existing window.

In order to make out a prima facie case of obviousness, the references must provide all of the elements of the invention as claimed and a suggestion to combine the disclosures of the various cited art references to make the claimed invention. See, *In re Geiger*, 815 F.2d 686,688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2143.03 (2005). As discussed above, Rodden and Buote, singularly and in combination, fail to disclose or suggest the claimed requirement of "if the size and position are not specified, determining the screen resolution for the display screen and automatically maximizing the size of the window on the display screen if the screen resolution is below a pre-determined threshold value, wherein the screen resolution does not change. Accordingly, for at least the foregoing reasons, the 35 U.S.C. § 103(a) rejection of claims 1 and 8 should be withdrawn and claims 1 and 8 should be allowed.

Claims 3-9, and 11-13 depend from claims 1 and 8 are allowable at least by their dependency on claims 1 and 8. Accordingly for at least the foregoing reason with respect to claims 1 and 8, Claims 3-9, and 11-13 the 35 U.S.C. § 103(a) rejection of claims 3-9, and 11-13 should be withdrawn and claim 1 should be allowed.

With respect to claims 4, 11 and 14, the Office Action fails to provide any citation to a reference, including Buote and Rodden to disclose or suggest a window having a restore button, where it is determined if the restore button has been initiated if the window has been maximized; and if the restore button has been initiated, reducing the size of the window on the display screen by a pre-determined amount. The Office Action indicates that this is either inherent or well known. Applicants respectfully ask the Office

to provide a reference to teach the claimed requirement if it is so well known to have the claimed requirement of claims 4, 11 and 14, with respect to the restore button. Additionally, as indicated above probabilities do not support an inherency argument. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.) Accordingly, the Office is asked to provide a basis in fact or technical reasoning to support the conclusion that utilizing the restore button when in a maximized size is an inherent characteristic that flows from the teachings of Rodden and Büote.

CONCLUSION

Claims 1, 3-9, and 11-14 are pending in this application. In view of the amendments and remarks, applicants respectfully request that this application be allowed and passed to issue. Should any issues remain prior to issuance of this application, the Examiner is urged to contact the undersigned prior to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.81059.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 19-2112 (Attorney Docket No: MFCP.81059).

Respectfully submitted,

Date: April 6, 2006

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